UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte ERIC OWHADI and RAJPAL GILL

_____

Appeal 2009-003737
Application 10/652,892
Technology Center 2100

_____

Decided: April 26, 2010

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Before JOHN A. JEFFERY, JAMES D. THOMAS, and
ST. JOHN COURTENAY III, *Administrative Patent Judges.*

COURTENAY, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) (2002) from the
Examiner's rejection of claims 1-20. We have jurisdiction under 35 U.S.C.
§ 6(b).

We affirm.

STATEMENT OF THE CASE

INVENTION

The invention on appeal relates to "technical support systems which are used to provide users of electronic devices, data processing apparatus and computer systems with post-sale technical support, whereby software, hardware or other operational problems and difficulties may be resolved without the need for the user to return the equipment to the point of sale or to take the apparatus to a workshop or the like." (Spec. 1, ll. 5-10).

ILLUSTRATIVE CLAIM

1.   A method of obtaining technical support for a data-processing device, comprising initiating a support session during which device-specific data is conveyed from the device to a support provider to assist the support provider in responding to a support query, and polling the support provider for a response to the query, on a repeated and automated basis, until a response becomes available or the support session is terminated.

PRIOR ART

The Examiner relies upon the following references as evidence:

Bereiter   US 6,145,096   Nov. 7, 2000

Monica Pawlan et al., "Signed Applets, Browsers, and File Access", Sun Microsystems, pp. 1-5, Apr. 1998. (hereinafter "Pawlan").

Indigo Rose Software Forums, "AutoPlay After Restart", p. 1, Mar. 2001. (Hereinafter "Indigo").

THE REJECTIONS

1. The Examiner rejected claims 15-17 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement.

2. The Examiner rejected claims 15-17 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

3. The Examiner rejected claims 1, 2, 8, 9, and 12 under 35 U.S.C. § 102(b) as anticipated by Bereiter.

4. The Examiner rejected claims 10, 11, 13-18, and 20 under 35 U.S.C. § 103(a) as unpatentable over the combination of Bereiter and Pawlan.

5. The Examiner rejected claims 3-7 and 19 under 35 U.S.C. § 103(a) as unpatentable over the combination of Bereiter, Pawlan, and Indigo.

CLAIM GROUPING

Based upon Appellants' arguments in the Brief, we select claim 1 and as the representative claim for the anticipation rejection, and we select claims 13 and 3 as representative claims for the first and second stated obviousness rejections, respectively. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUES

Based upon our review of the administrative record, we have determined that the following issues are dispositive in this appeal:

Issue 1:   Under the written description requirement of § 112, first paragraph, did the Examiner err by finding that the subject matter of the "computer readable medium" is not supported in the Specification as originally filed? (Claim 15).

Issue 2:   Under § 101, did the Examiner err in concluding that claims 15-17 are directed to non-statutory subject matter?

Issue 3:   Under § 102, did the Examiner err by finding that Bereiter discloses "polling the support provider for a response to the query, on a repeated and automated basis, until a response becomes available or the support session is terminated?" (Claim 1).

PRINCIPLES OF LAW

112 first paragraph, Written Description

Recently, the Court of Appeals for the Federal Circuit decided en banc the scope and purpose of the written description requirement within the first paragraph of 35 U.S.C. § 112. The court reaffirmed that the written description requirement found in the first paragraph of 35 U.S.C. § 112 is separate and distinct from the enablement requirement of that provision. *Ariad Pharms., Inc. v. Eli Lilly and Co.*, --- F.3d ----, 2010 WL 1007369, at *12 (Fed. Cir. 2010) (en banc) (*citing Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1562-63 (Fed. Cir. 1991)). Further, the purpose of the written

description requirement in 35 U.S.C. § 112, first paragraph, is to "clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed." *Ariad*, 2010 WL 1007369, at *12.

Accordingly, "the test for sufficiency is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date." *Id.* (*citing Ralston Purina Co. v. FarMar-Co, Inc.*, 772 F.2d 1570, 1575 (Fed. Cir. 1985)). The hallmark of the written description is disclosure. *Ariad*, 2010 WL 1007369, at *12. As such, not just possession, but "'possession as shown in the disclosure' is a more complete formulation." *Id.* Thus, the test for whether the claims are adequately described "requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art." *Id.* "Based on that inquiry, the specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed." *Id.* This inquiry is a question of fact. *Id.* (*citing Ralston Purina*, 772 F.2d at 1575). "[T]he level of detail required to satisfy the written description requirement varies depending on the nature and scope of the claims and on the complexity and predictability of the relevant technology." *Ariad*, 2010 WL 1007369, at *12 (*citing Capon v. Eshhar*, 418 F.3d 1349, 1357-58 (Fed. Cir. 2005)).

Anticipation under § 102

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation." *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citing *Minn. Mining & Mfg.*

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Co. v. Johnson & Johnson Orthopaedics, Inc., 976 F.2d 1559, 1565 (Fed.
Cir. 1992)).

> Anticipation of a patent claim requires a finding that the claim
> at issue 'reads on' a prior art reference. In other words, if
> granting patent protection on the disputed claim would allow
> the patentee to exclude the public from practicing the prior art,
> then that claim is anticipated, regardless of whether it also
> covers subject matter not in the prior art.

Atlas Powder Co. v. IRECO, Inc., 190 F.3d 1342, 1346 (Fed. Cir. 1999)
(citations omitted).

FINDINGS OF FACT

In our analysis *infra,* we rely on the following findings of fact (FF)
that are supported by the record:

Appellants' Specification

1. Independent claim 15 was amended on May 1, 2007 to recited "A
software element <u>on a computer readable</u> medium . . . ."

The Bereiter Reference

2. Bereiter discloses:

> Generalizing, and with reference to FIG. 2, the
> *automated* diagnostic method of the present invention may be
> implemented in any remote distributed node "under test" 30
> connectable to a diagnosis center operating at a server node 32.
> A problem at the remote distributed node is diagnosed (and
> preferably rectified) according to the invention using an
> "iterative problem solving session" between the remote
> distributed node 30 and the server node 32. An iterative
> problem solving session refers to set of communications back
> and forth between the node under test and the diagnostic center
> by which a solution to a technical problem is reached. A session

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> may involve only one "pass" or iteration although, more
> typically, several iterations will be required to move toward a
> corrective action to be implemented at the client node.

(Col. 4, l. 60 — col. 5, l. 7, emphasis added).

3. Bereiter discloses:

> A block diagram of the "client" piece of the present invention is
> illustrated in FIG. 4. The client piece executes on the machine under
> test (i.e. the machine on which the technical problem has arisen) to
> perform an initial diagnosis in response to a given occurrence (e.g., a
> PANIC), to submit the diagnosis to the diagnostic center, and to
> collaborate with the server components in the center to perform
> further tests in an iterative manner, and, if possible, to make repairs.
> The major client components includes a session manager 50, a
> diagnostic engine 52 and a graphical user interface (GUI) 54. The
> session manager 50 takes the initial diagnosis (using a diagnostic
> map), submits it to the server, tracks open problems, and coordinates
> the flow of information between the client and the support center.

(Col. 6, ll. 9-22).

ANALYSIS

Issue 1

We decide the question of whether the Examiner erred in finding

under the written description requirement of § 112 that the subject matter of

the recited "computer readable medium" is not supported in the

Specification as originally filed.

In the principal Brief (7), Appellants restate the Examiner's rejection

and submit the following arguments in opposition:

> Appellants submit that this rejection elevates form over
> function to heights bordering on the preposterous, as the
> Examiner is in effect asserting that a person of skill in the

> art of computers would not understand, after reading
> Appellants' disclosure, that the computer method disclosed
> therein may be provided on a computer readable medium.
> Appellants apologize for having to waste the Board's time with
> a response to this assertion, and respectfully request the Board
> to overturn this rejection on Appeal and, perhaps, educate the
> Examiner as to why the disclosure of computer implemented
> methods would *imply* to the skilled person the use of computer
> readable media.

(App. Br. 7, emphasis added).

For the reasons discussed *infra*, we decline to accept Appellants'
invitation to "educate the Examiner." (*Id.*).

Contrary to the Appellants' strenuous contention that the Examiner's
"rejection elevates form over function to heights bordering on the
preposterous" (*id.*), we find the evidence before us supports the Examiner's
finding of fact.[1] Based upon our review of the record, we find that
Appellants' independent claim 15 was amended on May 1, 2007 to recite "A
software element on a computer readable medium . . . ." (FF 1, underline
added to emphasize new matter). As discussed *infra*, we find Appellants
have provided no evidence to demonstrate that the disputed "computer
readable medium" was present in the written description as originally filed.
(Claim 15).

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[1] The determination of whether a patent meets the written description
requirement is a "question of fact, judged from the perspective of one of
ordinary skill in the art as of the relevant filing date." *Falko-Gunter Falkner
v. Inglis*, 448 F.3d 1357, 1363 (Fed. Cir. 2006) (citing *Vas-Cath*, 935 F.2d at
1563-64 (Fed. Cir. 1991).

When a claimed limitation is not present in the written description, it must be shown that a person of ordinary skill would have understood, at the time the application was filed, that the description requires that limitation. *See Hyatt v. Boone*, 146 F.3d 1348, 1353 (Fed. Cir. 1998).

Here, we note that Appellants' arguments *supra* (App. Br. 7) fail to point to <u>any specific portion</u> of the Specification that would have purportedly conveyed with reasonable clarity to those skilled in the art that Appellants were in possession of the disputed claim limitation (a computer readable medium). *See Purdue Pharma L.P.*, 230 F.3d at 1323. Thus, we find Appellants have made no showing explaining why a person of ordinary skill would have understood, at the time the application was filed, that the description requires a computer readable medium.[2]

Moreover, prior to the amendment entered May 1, 2007, we agree with the Examiner that Appellants' claim 15 was directed to "[a] software element," i.e., software per se. (Ans. 3-4; see further discussion *infra* regarding the Examiner's § 101 rejection).

While Appellants urge the Board to "educate the Examiner as to why the disclosure of computer implemented methods would *imply* to the skilled person the use of computer readable media" (App. Br. 7), we note that the question of written description support should not be confused with the

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[2] We note that mere attorney arguments and conclusory statements that are unsupported by factual evidence are entitled to little probative value. *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *see also In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984); 37 C.F.R. § 1.111(b); and *Ex parte Belinne*, No. 2009-004693, slip op. at 7-8 (BPAI Aug. 10, 2009) (informative), *available at* http://www.uspto.gov/web/offices/dcom/bpai/its/fd09004693.pdf

question of what would have been obvious (i.e., implied) to the artisan. Whether one skilled in the art would find the instantly claimed invention obvious in view of the disclosure is not an issue in the "written description" inquiry. *In re Barker*, 559 F.2d 588, 593 (CCPA 1977). A description which renders obvious the invention for which the benefit of an earlier date is sought is not sufficient. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997).

This reasoning is applicable here. On this record, we find the Examiner did not err in finding under the written description requirement of § 112 that the subject matter of the recited "computer readable medium" is not supported in the Specification as originally filed.

Issue 2

35 U.S.C. § 101

We decide the question of whether the Examiner erred in concluding that claims 15-17 are directed to non-statutory subject matter under § 101.

In the principal Brief (7-8), Appellants restate the Examiner's rejection and submit the following arguments in opposition:

> Appellants note at the outset that in the space of one paragraph, the Examiner has elevated the skilled person from being confounded by a description that does not explicitly direct him to use computer readable media to a state where he is able to ignore the specific recitation of such computer readable media and instead focus upon the software instructions contained thereon, "per se." More to the point, Appellant note that this pronouncement on the Examiner's part is completely senseless. Whatever may "appear" to the Examiner aside, all words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494,496 (CCPA 1970)." (emphasis added) It is a

> well settled corollary of this doctrine that no word in a claim
> can be ignored, as the Examiner attempts to do here. The mete
> and bounds of Appellants' invention is defined by the claims,
> and claim 15 very clearly recites a computer readable medium.
> Appellants respectfully request the Board to overturn this
> meritless rejection on Appeal as well, and pass this case to
> issue.

(App. Br. 7-8, underline in original).

For the reasons discussed *infra*, we decline to accept Appellants'
invitation to "overturn this meritless rejection on Appeal . . . and pass this
case to issue." (*Id.*).

At the outset, we note that the Board has no authority to issue
patents.[3]

Secondly, (as discussed *supra*) we agree with the Examiner that prior
to the amendment entered May 1, 2007, Appellants' claim 15 was directed
to "[a] software element," i.e., software per se. (Ans. 3-4). Thus, Appellants
ground their arguments urging reversal of this rejection on new matter added
by amendment. As previously discussed, we find the Examiner did not err in
finding under the written description requirement of § 112 that the subject
matter of the recited "computer readable medium" is not supported in
Appellants' Specification as originally filed.

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[3] *See* 35 U.S.C. § 6(b) ("The Board of Patent Appeals and Interferences
shall, on written appeal of an applicant, review adverse decisions of
examiners upon applications for patents . . . .").

Thirdly, we conclude that the "software element" coupled with a statement of intended use [4] of claims 15-17 is directed to an abstract idea. A claim that recites no more than software, logic or a data structure (i.e., an abstraction) does not fall within any statutory category. *In re Warmerdam*, 33 F.3d 1354, 1361 (Fed. Cir. 1994). Laws of nature, abstract ideas, and natural phenomena are excluded from patent protection. *Diamond v. Diehr*, 450 U.S. 175, 185 (1981).

For at least these reasons, we find the Examiner did not err in concluding that claims 15-17 are directed to non-statutory subject matter under §101.

Issue 3

We decide the question of whether the Examiner erred in finding under § 102 that Bereiter discloses "polling the support provider for a response to the query, on a repeated and automated basis, until a response becomes available or the support session is terminated." (Claim 1).

Appellants contend that "[c]ontrary to the Examiner's assertion, the client of Bereiter does not poll the support provider for a response; rather, the support provider keeps polling the client (by repeatedly sending new

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[4] "An intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates." *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345 (Fed. Cir. 2003). Although "[s]uch statements often . . . appear in the claim's preamble," *In re Stencel*, 828 F.2d 751, 754 (Fed. Cir. 1987), a statement of intended use or purpose can appear elsewhere in a claim. *Id.*

diagnostic maps to be solved by the client/on the client machine) until the support provider is able to identify the problem and offer a solution." (App. Br. 4).

Appellants particularly urge reversal of the Examiner's rejection for the following reasons:

> There are but two devices recited in claim 1, the data-processing device and the support provider. Furthermore, the claim clearly recites a method of obtaining technical support <u>for the data-processing device</u>. Is the Examiner suggesting that it is not the data-processing device that is conducting the polling of the support provider? Does he suggest that a skilled person (or anyone with a decent command of the English language, for that matter) would interpret the claim as teaching that the support provider polls itself! Or does he interpret the claim as teaching that a third, unidentified, entity conducts this polling? Of course, merely spending a few extra minutes actually reading the specification would have eased all of these doubts from the Examiner's mind, as he would have then unequivocally learned that yes, it is indeed the client that conducts the polling of the support provider.

(App. Br. 5, underline in original).

Regarding Appellants' first contention, we begin our analysis by observing that Appellants have not pointed to or argued a particular definition or intended meaning for the claim term "polling." Thus, we conclude that the metes and bounds of the claimed "polling" are intended to be broad. Therefore, we see no error in the Examiner's finding that "polling" broadly but reasonably reads on Bereiter's iterative inquiries (from the client to the server) to see whether the problem can be identified at the server:

> Clearly, after the client sends a data set to the server, the client is making a inquiry (e.g., polling) to the server asking to see if the problem can be identified or asking the server to see if the server needs any further information. If the problem can be identified based on the information provided, the client is provided with the solution and the client ends the inquiry. If the problem cannot be identified, the client repeats the inquiry with a new data set on an automated basis, until a response becomes available or the support session is terminated.

(Ans. 13).

Moreover, we note that Bereiter discloses (with reference to FIG. 2), an "*automated* diagnostic method [that] . . . may be implemented in any remote distributed node [i.e., client] "under test" 30 connectable to a diagnosis center operating at a server node 32. A problem at the remote distributed node is diagnosed (and preferably rectified) according to the invention using an "iterative problem solving session" between the remote distributed node 30 and the server node 32." (FF 2). Thus, we find Bereiter discloses a method of obtaining technical support for a data-processing device (client), within the meaning of Appellants' claim. (Claim 1).

Because polling is iterative in nature, we find Bereiter's "iterative problem solving session [that] refers to set of communications back and forth between the node under test [client] and the diagnostic center [server] by which a solution to a technical problem is reached" necessarily involves "polling" (i.e., iterative inquiries) by the client until a solution is provided by the server. (FF 1). We particularly note that Bereiter discloses a session manager 50 that is described as a major client component where "[t]he session manager 50 takes the initial diagnosis (using a diagnostic map),

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submits it to the server, tracks open problems, and <u>coordinates the flow of information between the client and the support center</u> [server]." (FF 3, underlined added).

For at least the aforementioned reasons, we find the Examiner did not err in determining under § 102 that Bereiter discloses "polling the support provider for a response to the query, on a repeated and automated basis, until a response becomes available or the support session is terminated." (Claim 1). Therefore, we sustain the Examiner's § 102 rejection of representative claim 1, as well as associated dependent claims 2, 8, 9, and 12 which fall therewith.

Limitations under § 103

Regarding the remaining independent claims 13, 14, 15, and 18, Appellants essentially restate the previous argument that Bereiter does not disclose polling by the client, but rather polling by the support provider or server. (App. Br. 6).

Thus, for the same reasons discussed *supra* regarding claim 1, we do not find Appellants' arguments regarding the claimed polling to be persuasive. Therefore, we affirm the Examiner's rejection of representative claim 13 as unpatentable under § 103 over the combination of Bereiter and Pawlan. Claims 10, 11, 14-18, and 20 fall therewith. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Regarding claims 3-7 and 19 that the Examiner rejected under § 103 as unpatentable over the combination of Bereiter, Pawlan, and Indigo, Appellants contend these claims are allowable by virtue of their dependency from claims 1 and 18, respectively. (App. Br. 7). Thus, for the same reasons discussed *supra* regarding claims 1 and 18, we do not find Appellants' arguments to be persuasive. Accordingly, we affirm the Examiner's rejection of representative claim 3 as unpatentable under § 103 over the combination of Bereiter, Pawlan, and Indigo. Claims 4-7 and 19 fall therewith. *See* 37 C.F.R. § 41.37(c)(1)(vii).

CONCLUSIONS

Based on the findings of facts and analysis above:

The Examiner did not err in finding under the written description requirement of § 112 that the subject matter of the recited "computer readable medium" is not supported in the Specification as originally filed.

The Examiner did not err in concluding that claims 15-17 are directed to non-statutory subject matter under §101.

The Examiner did not err in determining under § 102 that Bereiter discloses "polling the support provider for a response to the query, on a repeated and automated basis, until a response becomes available or the support session is terminated." (Claim 1; *see* commensurate limitations argued regarding representative claim 13 rejected under § 103).

ORDER

We affirm the Examiner's rejection of claims 15-17 under 35 U.S.C. § 112, first paragraph.

We affirm the Examiner's rejection of claims 15-17 under 35 U.S.C. § 101.

We affirm the Examiner's rejection of claims 1, 2, 8, 9, and 12 under 35 U.S.C. § 102(b).

We affirm the Examiner's rejection of claims 3-7, 10, 11, and 13-20 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

<u>AFFIRMED</u>

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